

Atty. Docket No. 390.0002
Amendment Dated October 19, 2005
Reply to Office action of August 26, 2005
Appl. No.: 10/766,196

PATENT APPLICATION

REMARKS

Upon entry of this Amendment, claims 1-6 and 8-11 are all the claims pending in the application. Claim 7 is canceled. Claim 1-11 has been examined and all of these claims have been rejected. Specifically, claim 6-9 and 11 has been rejected under 35 U.S.C. § 112, first paragraph, for allegedly failing to be enabled by the specification; Claim 1-5 and 10 have been rejected under 35 U.S.C. § 103 as being unpatentable over Sherman in view of Pitts or Hockaday; Claims 6 and 8 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Kuhns et al.; Claims 6-8 and 11 have been rejected under 35 U.S.C. § 102(b) as being unpatentable over Prince; and Claim 9 has been rejected under 35 U.S.C. § 103 as being unpatentable over Kuhns et al.

For the reasons set forth below, Applicant respectfully traverses the rejections and requests favorable disposition of the application.

Argument

Rejection Under 35 U.S.C. § 112, ¶1

In regard to the rejection under 35 U.S.C. § 112, first paragraph, the grounds of rejection assert that the language recited in claim 6 is not enabled by one of ordinary skill in the art. Specifically, it is asserted that the specification does not disclose "the chemical properties of the cover and its associated chemical properties which initiate a reaction process".

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In response to this rejection Applicant submits that a person of ordinary skill in the art upon reading the application would know how to make and use the invention. In particular, regarding the disclosed and claimed disappearing guidance means of claim 6, a skilled artisan would know that one well known way to make a so-called disappearing ink is related to acid/base chemistry and utilizes pH indicators. For example, as disclosed in U.S. Patent No. 4,171,982 to Lin. Further "[a] patent need not disclose what is well known in the art." *In re Wands*, 858 F.2d 731, 735 (Fed. Cir. 1988). One of ordinary skill would know that most well known disappearing inks are applied as a pH indicator. The indicator is an acid-base indicator that is colored in base and colorless in acid. When an acidic liquid is applied to the indicator, the pH is lowered and the indicator becomes colorless.

As described at page 7, paragraph [0030] of the specification, the activating cover is preferably treated with a chemical, e.g., a reactionary agent, and it is this chemical that initiates disappearance of the ink. One example of the reactionary agent could be the acidic solution described above which acts with a colored base indicator on the paper.

For the aforementioned reasons it is submitted that claim 6 satisfies the requirements of 35 U.S.C. § 112 and, accordingly, the rejection of claims 6-9 and 11 should be withdrawn.

Prior Art Rejections

In regard to the rejection of claim 6 and 8 under 35 U.S.C. § 102 as being anticipated by Kuhns et al., Applicant submits that Kuhns et al. fails to teach or suggest the recited "writing surface including a penmanship improving indicia" and "an activating cover treated with a reactionary agent for initiating a reaction process with the penmanship improving indicia when said activating cover is placed over said writing surface, thereby causing said substance to disappear."

Kuhns et al. discloses a presentation folder in which custom printing sheets are heat laminated to the face of the folder. (abstract). In FIG. 8 horizontal and vertical fiducials (23 and 25, respectively) are shown. The fiducials are for aligning an insert sheet (17 in FIG. 7) with respect to the edges of the folder. Indeed, it is disclosed a column 7, lines 3-10, that the fiducials would ideally disappear. However, the fiducials are made to disappear upon being exposed to heat, e.g., heat from the lamination process. Accordingly, the presentation folder of Kuhns et al. includes fiducials for aligning an insert sheet. Penmanship improving indicia are not anywhere contemplated in Kuhns et al. Furthermore, there is no cover treated with a reactionary agent for reacting with the ink to make it disappear. Instead, the fiducials of Kuhns et al. disappear upon being treated with heat. For at least these reasons, Kuhns et al. does not anticipate claim 6 or claim 8, which depends from claim 6.

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With respect to §103 rejection of claim 9 as being unpatentable over Kuhns et al., Applicant submits that claim 9 is patentable over Kuhns et al. for at least the same reason as discussed above with respect to claim 6, from which claim 9 depends.

Regarding the rejection of claims 6-8 and 11 as being anticipated by Prince (U.S. Publication No.2004/0142306), Applicant respectfully submits that Prince fails to teach at least "a writing surface including a penmanship improving indicia." Prince, in comparison, discloses a system for applying a grid to an artistic painting canvas. (abstract). The grid assists in "sketching, illustrating, drawing or painting". (abstract). At par. [106] other uses, such as "children's toys, tee shirts with disappearing patterns, marking patterns for quilting and sewing, hose-washable store window painting' are disclosed. However, penmanship improving indicia, for example for improving the legibility of a hand-written note, are not disclosed. For at least this reason, Prince does not teach, or otherwise disclose, the subject matter of claims 6-8 and 11.

Lastly, with respect to the rejection of claims 1-5 as being obvious over Sherman in view of Pitts or Hockaday, Applicant reiterates and clarifies the previous arguments set forth in the response filed May 21, 2005. In particular, in regard to claim 1, the proposed combination of Sherman and either Pitts or Hockaday fails to disclose;

a marking area comprising penmanship improving indicia
comprising ink capable of disappearing; and
an overlying barrier sheet for preventing permeation of air, said
overlying barrier sheet being removably affixed to the marking area,
wherein removal of said overlying barrier sheet initiates a chemical

reaction process in which said ink disappears after passage of a certain amount of time

Specifically, the grounds of rejection assert that "Pitts and Hockaday both clearly teach that it is known to provide a substrate and indicia in a relationship such that the indicia disappears or is removed after functioning as a guide device." (Office Action, page 5, line 2-4). Applicant respectfully disagrees with this assertion. The "guide markings" of Pitts and the "lettering guides" of Hockaday are completely different than the claimed penmanship improving indicia recited in claim 1. For example, in Pitts, the guide markings do not even disappear. Instead, as expressly recited at column 2, lines 10-13, "[t]he essential feature of the invention is that the guide markings are visually perceptible at a writing distance away from the posterboard, but are substantially imperceptible at a viewing distance away from the posterboard." That is, the guide markings are written so faintly that they are only perceived by persons that are very close to the board. On the other hand, a person that is a "reasonable distance away" from the board can not perceive the guide markings. This is completely different from, and has nothing whatsoever to do with, applying penmanship improving indicia that disappear over a certain amount of time due to a chemical reaction.

Hockaday also discloses a device and method that has nothing whatsoever to do with penmanship improving indicia that disappears upon the initiation of a chemical reaction. In particular, the letter guide disclosed in Hockaday comprises "releasable

adhesive-mounted parallel strips" attached to substrate, such as a name tag, etc. As illustrated in FIG. 2, the edges of the parallel strips serve as guides so a person can write on the substrate, i.e., between adjacent parallel strips, with uniform letter height and a straight line.

Accordingly, the proposed combination of Sherman and either Pitts or Hockaday does not teach or suggest a marking area with penmanship improving indicia that disappears upon the initiation of a chemical reaction that occurs when a barrier sheet is removed from the marking area.

As clearly set forth in *In re Gulack*, "the critical question is whether there exists any new and unobvious functional relationship between the printed subject matter and the substrate." *In re Gulack*, 703 F.2d 1381, 1386 (Fed. Cir. 1983). The grounds for rejection assert that it would have been obvious to provide the disappearing ink of Sherman in the arrangement of straight lines "since it would only depend on the intended use of the assembly and the desired information to be displayed and since Pitts and Hockaday both clearly teach indicia that disappears or is removed. As discussed above, however, neither Pitts nor Hockaday discloses indicia that either disappears or is removed via a chemical reaction. Furthermore, there is nothing in the prior art of record that provides motivation for a skilled artisan to make the "guide markings" of Pitts, for example, out of ink that disappears upon the initiation of a chemical reaction. Accordingly, even if all of the recited elements were found

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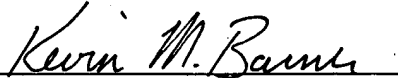
independently in the various cited prior art references, which they are not, claim 1 is patentable over the combination of references and the rejection of claim 1 should be withdrawn.

Claims 2-5 are patentable over the prior art of record at least by virtue of their dependence on independent claim 1.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If the Examiner is unable to allow the case on the next office action, **the Examiner is kindly requested to contact the undersigned at the telephone number listed below.**

Respectfully submitted,


Kevin M. Barner
Registration No. 46,075

CAHN & SAMUELS
Telephone: (202) 331-8777
Facsimile: (202) 331-3838

WASHINGTON OFFICE

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CUSTOMER NUMBER

Date: October 19, 2005